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TRANSMITTAL FORM

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Art Unit	3625
Examiner Name	Pond, Robert M.
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ENCLOSURES *(Check all that apply)*

- ☐ Fee Transmittal Form
  - ☐ Fee Attached
- ☐ Amendment/Reply
  - ☐ After Final
  - ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Response to Missing Parts/ Incomplete Application
  - ☐ Response to Missing Parts under 37 CFR 1.52 or 1.53
- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a Provisional Application
- ☐ Power of Attorney, Revocation Change of Correspondence Address
- ☐ Terminal Disclaimer
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- ☐ Proprietary Information
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Remarks The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

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Signature	
Date	September 27, 2004

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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	McCarthy, Mary K. et al.	)	Examiner: Pond, Robert M.
Serial No:	09/378,678	)	Art Unit: 3625
Filed:	August 20, 1999	)	Certificate of Mailing
Title:	METHOD OF AND SYSTEM FOR DELIVERING COMBINED SOCIAL EXPRESSION CARDS AND GIFT CERTIFICATES	)	I hereby certify that this paper or fee is being deposited with the United States Postal Service as first class mail under 37 C.F.R. § 1.8 on September 27, 2004, and is addressed to the Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. By:

REPLY BRIEF

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Sir:

In accordance with 37 C.F.R. §41.41, the Applicant files this Reply Brief.

Obviousness

The Examiner has not made a *prima facie* case of obviousness with respect to Claim 30. In order to make a *prima facie* case of obviousness, there must be a teaching, suggestion or motivation to make the claimed combination either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. It should be noted, however, that the level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 1161 (Fed. Cir. 1999).

The Examiner has not pointed to any teaching or suggestion or motivation in either the Small patent or the Borders.com reference to make the asserted combination. Rather, the Examiner has argued that the fact that the Small patent does not disclose the subject matter of

claim 30 leaves to "chance" whether a particular store may be located near a gift recipient. The Examiner then argues that a person skilled in the art would not leave something as important as whether a particular store is located near the recipient to "chance." Accordingly, the Examiner argues that a person skilled in the art would have obviously provided a feature so that a gift giver could determine if the particular store was near the recipient. The Examiner then goes out and finds a store locator feature in Borders.com.

The Applicant submits that the Examiner's argument is improperly based upon a hindsight reconstruction of the art in view the Applicant's disclosure. The Applicant has told the Examiner that Small does not include a locator feature. Small does not suggest that a locator feature would be a good thing to have. The Borders.com reference announces a "new Gift Center" that enables a customer to send merchandize or a gift certificate to a recipient. The Borders.com reference mentions "Should an online visit inspire *you* [the online customer] to check out a Borders store, Borders.com is equipped with a store locator function giving addresses and driving locations based on *your* zip code." (Emphasis added) The Borders.com reference does not disclose or suggest that the store locator and gift certificate features are in any way coupled together. The Borders.com reference does not say "Don't chance sending a gift certificate to someone who lives 500 miles from the nearest Borders store; check out our store locator", or words to that effect.

In neither the Small patent nor the Borders.com reference is there any suggestion to combine one with the other. The Examiner's "chance" argument is not based upon the teachings of the references; rather, it is his opinion, after knowing what the Applicant invented, that someone skilled in the art would not have done anything else. The Examiner has not made a *prima facie* case.

Official Notice

The Examiner's Answer contains the broad statement that "The Appellant did not traverse the examiner's assertion of official notice. The common knowledge or well-known in the art statement is taken to be admitted prior art because Appellant failed to traverse or adequately traverse the examiner's assertion of official notice.

The Applicant respectfully points out that the Examiner's assertion of official notice in Paper Number 11 was regarding privacy expectations and mailing practice in his rejection of

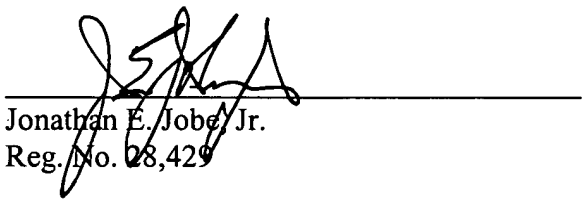
claims 21-24, only. Claims 22-24 depend from claim 21, which depends from claim 19, which depends from claim 30.

In this appeal, claims 6, 7, 16-29, 31 and 32 stand or fall with claim 30; the Applicant is not arguing for the patentability of claims 21-24 separately. The Examiner asserted official notice of privacy expectations and mailing practice only with respect to claims 21-24 and not with respect to claim 30. Accordingly, the Applicant did not, and was not required to, traverse the Examiner's assertion of official notice. The statement concerning the effect of the Applicant's failure to traverse the Examiner's assertion is gratuitous and has nothing to do with the issues in this appeal. Only the Small patent and the Borders.com citation are prior art in this appeal with respect to the patentability of claim 30. Privacy expectations and mailing practice are not relevant to the patentability of claim 30. The Examiner did not take official notice of anything apart from the references of record in rejecting claim 30. The Applicant's decision not to argue the patentability of claims 21-24 separately from that of claim 30 does not in any way amount a concession that the Examiner is correct in his opinion about what one skilled in the art would have done.

Conclusion

The Applicant has demonstrated that the Examiner's rejections are erroneous. Accordingly, the Examiner's rejections should be reversed.

Respectfully submitted,



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